

## **REMARKS**

Claims 1, 3-6, 8, 10-14, 16, 18-23, and 25 are pending in the application. Claim 2 has been canceled. Claims 7, 9, 15, 17, 24, and 26 have been withdrawn.

### ***Claim Rejection 35 U.S.C. § 112, paragraph 2***

By this paper Claim 2 has been canceled. Claim 1 has been amended to more particularly point out and distinctly claim the present invention in which the securing mechanism being constructed for securing the retention member in a desired orientation. Removal of the pending rejection under 35 U.S.C. §112, second paragraph is respectfully solicited.

### ***Claim Rejection 35 U.S.C. § 102***

#### **35 U.S.C. § 102(b)**

Claims 1 and 2 stand rejected under 35 U.S.C. §102(b) as anticipated by Vold, E. United States Patent Number 3,083744 (hereinafter Vold). Applicant respectfully traverses. As the relevant portion of the Outstanding Action is repeated from the Action dated December 6, 2004 Applicant respectfully re-forwards his arguments in the immediately preceding Reply. The entire Response to Arguments from the Instant Action is reproduced below for the Office's convenience.

#### ***Response to Arguments***

9. Applicant's arguments filed 10 March 2005 have been fully considered but they are not persuasive. The retention device of Vold requires a sliding and a pivoting motion to retract or extend. Figure 7 of Windstrup clearly shows a retention member (20) pivotally extending out of the housing to an extended position (ghost line 20) and pivotally retracting into the housing to a retracted position (solid line 20). Figure 7 of

Windstrup, also clearly shows a deck housing the adjustable device, the retention member, and the securing mechanism (12). Figure 7 clearly shows retention member pivotally extending out of the housing and then pivotally retracting back into the housing. The retention member in Windstrup clearly pivotally extends exterior out of the housing just as much as the retention member, of the instant application, extends exterior to the housing. It is inherent that the apparatus, of Windstrup, must be on top of a table-like structure to support the apparatus. Whatever structure Windstrup's apparatus is supported by would then become a work deck. Wilson et al. teaches that it is old and well known to have deformable tabs.

#### Instant Action, Pages 5 and 6

Applicant respectfully request the Office clarify what precise rejection the Office is forwarding as the entirety of the Vold rejection seems to be a simple one sentence assertion and a reference to Windstrup (United States Patent Number 4,423,860, hereinafter Windstrup). Applicant notes a Windstrup rejection is not applicable as there has been no denomination of a 35 U.S.C. §102(b) to Claims 1 and 2 over Windstrup. As the Examiner is aware, the examiner "ordinarily should reject each claim on all valid grounds available." *M.P.E.P.* §707.07(g) Further, "[w]here a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression." *Id.*

Vold discloses a folding stop gauge in-which a sliding action is required to stow the blade 31. In order for the blade 31 to be stowed, the user must slide the blade into the holder 28 which retains the blade. See also Vold, Col. 2, lines 39-43. This is not the present invention as Vold requires a user to slide the blade into a stowed position which is held by the holder 28. Claim 1 recites an apparatus in which a retention member is capable of pivotally obtaining an extended orientation and a retracted orientation and includes a securing mechanism being constructed for securing the retention member in a desired orientation. Vold fails to teach every aspect of the invention as Vold fails to disclose an apparatus in which a retention member, capable of pivotally obtaining an extended and retracted orientation and a securing mechanism being constructed for securing the retention

member in a desired orientation are included. Rather, the asserted securing member of Vold (the pin 29) does not secure the retention member but, instead, merely acts as a pivot point. As such, the asserted securing member is not capable of being constructed for securing the retention member in a desired orientation as the holder 28 is utilized for stowage and is incapable of retaining the blade (the asserted retention member) when the blade is extended. Additionally, the Vold device allows the blade 31 to move freely when in a non-stowed position as the pin is incapable of securing the blade in the desired orientation. Removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

Claims 3-6, 10 (apparently), 11, 13, 14, and 19-23 stand rejected under 35 U.S.C. §102(b) as anticipated by Windstrup, R., United States Patent Number 4,423,860 (hereinafter Windstrup). Applicant traverses the rejection.

Claim 3 recites an apparatus in-which “the retention member is capable of pivotally obtaining an extended orientation and a substantially retracted orientation for storage”. Windstrup fails to disclose this limitation. Windstrup discloses a vise clamp in-which the jaw 20 may rotate to engage/disengage with a screw so as to permit sliding of the jaw along rails 3, 3. Windstrup, Abstract and Col. 2, lines 29-59. At no time does Windstrup disclose that a substantially retracted orientation for storage may be obtained. The Windstrup device suffers from the problems experienced in the prior art inasmuch as the jaw in Windstrup is always substantially exposed and therefore, interferes with the placement of a workpiece when clamping is not desired. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221

USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added.

Additionally, the Office now recites items 35 (a nut) and 44 (threading included on an interior aperture of the nut) as the securing mechanism. Applicant disagrees. The nut and threading is incapable of being a securing mechanism, connected to the retention member, for securing the retention member in a desired orientation as the threading is incapable of securing the retention member in a desired angular orientation as the whole goal of the Windstrup reference is to allow the nut (including threading 44)/the jaw threading 44) to pivot into and out of engagement in order to permit rapid longitudinal positioning of the jaw along the screw. Windstrup makes no provision for pivotal securing. For example, if a user wanted to adjust the Windstrup device they would depress or raise the jaw/nut combination so that the threads are disengaged to allow the jaw to slide. Windstrup, Col. 2, lines 50-59. In other words, the jaw is not restrained in its pivotal motion by the nut but, rather, is restrained (longitudinally along the screw 40) by the nut. Therefore, the nut/jaw may be rotated as indicated by FIG. 7 as the nut is incapable of preventing rotation. Removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

Claims 5 and 6 are believed to be allowable based on their dependence from Claim 3 which is believed to be in a condition for allowance. Applicant will not burden the record. Removal of the pending rejection is respectfully requested.

Regarding Claim 10, Applicant respectfully requests clarification as to whether Claim 10 is pending a rejection under 35 U.S.C. §102(b). While the heading "In regards to claims 3-6 and 10:" appears on Page 3 of the Instant Action. It is believed that this is a typo as the Office admits on Page 5 that Windstrup does not teach a power tool. If a 102(b) rejection is pending, Applicant respectfully forwards the arguments presented in the immediately preceding paper.

Winstrup, FIGS. 6 and 7

10

Windstrup discloses the same invention including a housing (12) including a recess (Fig. 2), an adjustable positioning device disposed in the housing (40), a retention member connected to the adjustable positioning device (20), the retention member is configured to pivotally obtain an extended orientation and a retracted orientation (Fig. 7), a securing mechanism connected to the retention member for securing the retention member in a retracted orientation (35 and 40), the retention member is capable of pivotally extending exterior to the housing and retracting into the housing recess (Fig. 7), that the adjustable positioning device is a threaded rod (40), the retention member includes an aperture (22) with segmented threads for engaging the threaded rod (42 and 44), and the housing is capable of being included in a work deck (12).

#### Instant Action, Page 4

First, the Office fails to identify what structure(s) it considers the securing mechanism. Claim 11 and generally Claim 4 (depending from Claim 3), recite a securing member. Windstrup fails to teach a securing mechanism connected to the retention member. As the Office is aware, “[i]n proceeding before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art...” *In re Fritch*, 972 F.2d 1260, 24 USPQ.2d 1780, 1783 (Fed. Cir. 1992). Claim 4 is believed to be allowable based on its dependence from Claim 3. Claim 11 is believed to be allowable based on the same general rational as discussed in regards to Claim 3 with respect to the a securing mechanism inasmuch as Windstrup fails to disclose a securing mechanism connected to the retention member, for securing the retention member in at least one of the extended orientation and the retracted orientation. Removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

Claims 13 and 14 are believed to be allowable based on their dependence from Claim 11 which is believed to be in a condition for allowance. Removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

Claims 18 and 19 are believed to be allowable based on their dependence from Claim 11. Regarding Claim 18, Windstrup fails to disclose a housing which is included in a work deck. For example, a primary or auxiliary work deck of a miter saw, a drill press or the like. Instant application, paragraph [0022]. Instead, Windstrup simply teaches a separate clamp being designed to rest upon a work bench. Windstrup, Col. 1, lines 59-64. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)). Emphasis added.

Regarding Claim 19, Applicant respectfully requests clarification as to whether Claim 19 is pending a rejection under 35 U.S.C. §102(b). While the heading "In regards to claims 11, 13, 14, 18, and 19:" appears on Page 3 of the Instant Action. It is believed that this is a typo as the Office admits on Page 5 that Windstrup does not teach a power tool. If a 102(b) rejection is pending Applicant respectfully forwards the arguments presented in the immediately preceding paper. Regarding Claim 19, as discussed with respect to Claim 10, nowhere does the Windstrup reference teach or suggest integrating the apparatus with a power tool. Windstrup merely teaches a separate vise and therefore does not anticipate Claim 19. As a *prima facie* case of anticipation has not been shown, removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

Regarding Claims 20-23, by this paper, Claim 20 recites adjustable positioning means, means for retaining, and means for securing. The Windstrup reference fails to teach the combination of securing means capable of securing the retaining means in a desired orientation. First, nowhere does the Office identify which component(s) it considers the securing means rather the entirety of the rejection reads ". . . means for securing the

retaining means connected to the retaining means (35 and 44),. . .” Rather, Windstrup discloses a system in-which a nut (including threading) and a jaw may be manipulated to engage/disengage threading to allow for sliding adjustment. Additionally, Windstrup does not teach retaining means capable of obtaining a substantially retracted orientation and presently claimed. Windstrup merely teaches a jaw which may be tilted to permit adjustment and is not capable of obtaining an extended orientation and a retracted orientation as recited. Removal of the pending rejection under 35 U.S.C. §102(b) is respectfully requested and allowance is earnestly solicited.

### ***Claim Rejection 35 U.S.C. § 103***

#### **35 U.S.C. § 103(a)**

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *See MPEP § 2141 and Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 220 USPQ 182, 187 n.5 (Fed. Cir. 1986).

Claims 8, 16, and 25, stand rejected under 35 U.S.C. §103(a) over Windstrup in view of Wilson, et al. United States Patent Number 5,146,832 (hereinafter Wilson). The rejection is respectfully traversed. As noted above, Windstrup fails to disclose each and every limitation including a retention member capable of pivotally obtaining an extended orientation and a substantially retracted orientation for storage as recited in Claim 3, from which Claim 8 depends, as well as, a securing mechanism connected to the retention member, for securing the retention member in a desired orientation. The combination of Windstrup in view of Wilson fails to correct these defects.



First, there is no motivation to combine Windstrup with Wilson as the references are grouped in different classes (Windstrup 269/180 and Wilson 83/698) and have no common feature or purpose. Windstrup is directed to a vise and Wilson is directed to a punch pad and punch tip. As the Office is aware, [t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or the knowledge generally available to one of ordinary skill in the art." *M.P.E.P.* §2143.01. Emphasis added

The Wilson reference is being cited as correcting the deficiency in Windstrup; this Wilson fails to do. Wilson discloses a system in which the tab 46 is not included on the punch tip 70 (the adjustable portion) but instead is integrated into the punch pad or the base 30. Wilson, FIG. 4A. This is not the present invention. Claim 3 recites "a securing mechanism connected to the retention member, for securing the retention member in a desired orientation." Therefore, the combination of Windstrup in view of Wilson, on the whole, fails to teach the present invention as the tab 46 is not connected to the adjustable portion but included in the base. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). Emphasis added. Additionally,

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves

would have been obvious, but whether the claimed invention as a whole would have been obvious. *M.P.E.P. §2141.02 citing Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed Cir. 1983).  
Emphasis original.

Removal of the pending rejection under 35 U.S.C. §103(a) to Claims 8, 16, and 25 is requested and allowance is earnestly solicited.

Claims 10 and 19 stand rejected as obvious over Windstrup in view of Chen United States Patent Number 5,483,858 (hereinafter Chen). Applicant respectfully traverses the rejection.

The Office is correct that Windstrup fails to teach an integrated device. The Office is incorrect that Chen fails to correct the deficiencies of Windstrup. First, Windstrup fails to teach “the retention member is capable of pivotally obtaining an extended orientation and a substantially retracted orientation for storage”, as well as, “a securing mechanism connected to the retention member, for securing the retention member in a desired orientation”. Wilson fails to correct these deficiencies. Additionally, the Windstrup/Chen combination fails to teach the retention member is capable of pivotally obtaining an extended orientation and a substantially retracted orientation for storage. . . wherein the apparatus is integrated with a power tool as neither Windstrup, nor Chen alone or in combination teach or suggest an integrated apparatus wherein the retention member is capable of obtaining a substantially retracted orientation for storage. Chen discloses an adjustable clamping mechanism which will interfere with a large dimension workpiece position when not in use. Both Windstrup and Chen suffer from this defect which was experienced in the prior art as neither of the references alone or in combination teach or suggest a retention member is capable of pivotally obtaining an extended orientation and a substantially retracted orientation for storage. . . wherein the apparatus is integrated with a power tool. As a *prima facie* case of obviousness has not been proven, removal of the pending rejection under 35 U.S.C. §103(a) to Claims 10 and 19 is requested and allowance is earnestly solicited.

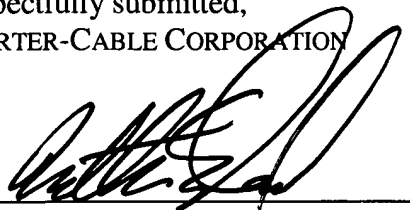
### CONCLUSIONS

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

DATED: August 25, 2005.

Respectfully submitted,  
PORTER-CABLE CORPORATION

By



Nathan T. Grebasch  
Reg. No: 48,600

SUITER · WEST · SWANTZ PC LLO  
14301 FNB Parkway, Suite 220  
Omaha, NE 68154-5299  
Telephone: (402) 496-0300  
Facsimile: (402) 496-0333